

Appl. No. 10/758,435
Resp./Amdt. dated Jun. 22, 2006
Reply to Office Action of 05/03/2005

REMARKS/ARGUMENTS

There are no amendments to the specification, drawings or claims herein.

Claims 1-35 remain and are pending in the application. Claims 1, 3-7, 10, 12-18, 20-24, 27 and 32-34 are provisionally rejected and Claims 2, 8, 9, 11, 19, 25, 26, 28-31 and 35 are objected to. Reconsideration is respectfully requested.

In the Final Office Action, the Examiner provisionally rejected Claims 1, 3-7, 10, 12-18, 20-24, 27 and 32-34 under 35 U.S.C. 101 as claiming the same invention as that of Claims 1-13, 15-20, 24 and 28-30 of copending Application No. 10/368,179 (hereinafter 'Copending Application'). In a response section of the Final Office Action, the Examiner contended that Applicant's arguments in a Response/Amendment filed February 2, 2006 (hereinafter 'Previous Response') were not persuasive, "because claims 1, 18 and 24 are not limited to 'more than two test ports' so multi-port still reads on two ports. Further, the Examiner objected to Claims 2, 8, 9, 11, 19, 25, 26, 28-31 and 35 as being dependent upon a rejected base claim but indicated that these claims would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims.

I. Statement of the Substance of an Interview with the Examiner

A telephone interview was conducted on June 7, 2006 between Examiner Elias Desta (hereinafter 'Examiner') and J. Michael Johnson, the undersigned Agent for Applicant. Also in attendance was the Examiner's supervisor, Examiner Marc C. Hoff, SPE. A Telephone Interview Outline was provided by Mr. Johnson to both Examiners Desta and Hoff via facsimile transmission prior to the interview. A copy of the Telephone Interview Outline is provided herewith as Appendix A.

During the telephone interview, the Final Office Action was discussed with reference to the single remaining rejection of Claims 1, 3-7, 10, 12-18, 20-24, 27 and 32-34 under 35 U.S.C. 101, Statutory Double Patenting. In particular, a **Response to Arguments** section of the Final Office Action beginning at Page 3 of the Final Office Action was discussed.

Mr. Johnson reminded the Examiner that an explicit definition of "multiport vector network analyzer" or "multiport VNA" is provided in Applicant's specification as originally filed. That definition unequivocally establishes for the purposes of the

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present invention that the claimed multiport VNA has, "more than two test ports" (Specification, Page 5, line 31). Mr. Johnson further reminded the Examiner that when an explicit definition of a claim term is provided the definition must be applied and relied upon in examining the application. See *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Also see MPEP § 2111.01 *Plain Meaning [R-3]*. Further, Mr. Johnson pointed out that at least rejected Claims 18 and 24 recite, "a multiport vector network analyzer having more than two test ports". Note that rejected base Claims 10 and 32 similarly recite a multiport VNA having more than two ports. Mr. Johnson queried how, given the definition in the specification and the language in the claims, the Examiner could still contend that the claims were not limited to a multiport VNA having more than two ports.

The Examiner agreed that the recitation by base Claims 18 and 24 of a multiport VNA "having more than two test ports" overcomes the provisional rejection under 35 U.S.C. 101. Furthermore, the Examiner agreed that other base claims (e.g., rejected base Claims 10 and 32) that recite "more than two" test ports similarly overcome the rejection. The Examiner acknowledged Applicant's right to be his/her lexicographer. The Examiner further acknowledged that the definition of "multiport VNA" provided by Applicant's specification can and does overcome the provisional rejection of base Claim 1 and those rejected claims that are dependent therefrom under 35 U.S.C. 101. Finally, the Examiner agreed that the provisional rejection of Claims 1, 3-7, 10, 12-18, 20-24, 27 and 32-34 under 35 U.S.C. 101 for statutory double patenting was overcome by the claims, as filed, and that the rejection would be withdrawn.

Mr. Johnson indicated that a Response/Amendment would be filed that included the Examiner's agreement to withdraw the provisional rejection in an Interview Summary section. Examiners Desta and Hoff agreed that all of the claims were allowable except in the "unlikely event that some new art might appear in the updated search". Examiner Hoff further stated that the interpretation of "multiport" to mean "more than two ports" would be confirmed in a paper that provides Reasons for Allowance.

Mr. Johnson concluded that the other items on the Telephone Interview Outline were effectively rendered moot by the Examiner's decision to withdraw the provisional rejection. The interview was terminated.

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II. Remarks

Applicant appreciates the Examiner's withdrawal of the rejections of Claims 2, 8, 9, 19 and 28-30 under U.S.C. 102(b) and 35 U.S.C 103(a) from a previous Office Action. Additionally, pursuant to the above-discussed agreement that was reached in the telephone interview of June 7, 2006, Applicant further appreciates the Examiner's pending withdrawal of the provisional rejection of Claims 1, 3-7, 10, 12-18, 20-24, 27 and 32-34 under 35 U.S.C. 101, statutory double patenting. At present, there are no extant rejections of any claims in the instant application.

In summary, Claims 1-35 are pending. Claims 1, 3-7, 10, 12-18, 20-24, 27 and 32-34 were provisionally rejected and Claims 2, 8, 9, 11, 19, 25, 26, 28-31 and 35 were objected to. As detailed hereinabove, both the aforementioned provisional rejection and pending objection is effectively withdrawn by the Examiner, thereby rendering Claims 1-35 in condition for allowance. It is respectfully requested that Claims 1-35 be allowed, and that the application be passed to issue at an early date.

Should the Examiner's action be other than allowance, the undersigned respectfully requests a telephone call from the Examiner to discuss further consideration that would expedite the prosecution of the application. Moreover, should the Examiner have any questions regarding the above, please contact the undersigned, J. Michael Johnson, telephone number (775) 849-3085, or John L. Imperato, Attorney for Applicant, Registration No. 40,026 at Agilent Technologies, Inc., telephone number (408) 553-2311.

Respectfully submitted,
TIBERIU JAMNEALA ET AL.

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on the date shown below.


J. Michael Johnson

6/22/06

Date

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APPENDIX A

Telephone Interview Outline

USSN: 10/758,435
Applicant: Tiberiu Jamneala

Agent for Applicant: Mike Johnson, (775) 849-3085
Examiner: Elias Desta
Supervisory Patent Examiner: Marc C. Hoff
Date/Time: 6/7/2006; 4:00 pm EDT

Papers Involved: Final Office Action: mailed 5/3/06.

Goal: Resolve and/or clarify issues and confusion regarding a provisional rejection under 35 U.S.C. 101 for statutory double patenting.

I. Questions regarding *Response to Argument* of Final Rejection.**A. "Multiport VNA" as defined and claimed.**

1. Examiner maintains that Multiport VNA recited in claims 1, 18, and 24 is not limited to "more than two test port".

Q. How are these claims not so limited?

- Specification defines "Multiport VNA at Page 5, line 31 to page 6, line 18. Claims 18 and 24 (plus claims 10, 29, and 32) explicitly recite "having more than two ports.

Q. What is the relevance of citing Randa when Applicant has provided and explicit definition which must be relied upon in examining the application? (See *In re Zeltz*; also see MPEP 2111.01 and 2111.02)

Q. How does Applicant's Figure 6 not show a multiport device?

II. Discrepancies and other issues.**A. Claims 28 and 29:**

Q. Why is Claim 28 mentioned in the *Response to Arguments* section as being rejected but is not included in the rejection on Page 2? Also, Claims 28-29 are indicated as being objected to but allowable if rewritten but Claims 28-29 are both independent claims.

B. Claims 1, 15, 25, 26 and 28 cancelled in co-pending application.

- Rejection relies on Claims 1-13, 15-20, 24 and 28-30 of co-pending application.
- Co-pending application has been allowed.

C. Rejection lacks literal infringement analysis.